

REMARKS

Claims 1-18 are pending in the application. No claims are presently allowed.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 4, 10-12, 17, and 18 have been rejected under 35 U.S.C § 102(b) as allegedly anticipated by Watanabe et al. (*J. Electrochem. Soc.*).

In order to make a *prima facie* case of anticipation, the reference must disclose each limitation of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP 2131. Among other deficiencies, the reference does not disclose the limitation in claims 1, 11, and 17 that the composition comprises $\text{SnO}_x \cdot y\text{H}_2\text{O}$. The attached Declaration Under 37 C.F.R. § 1.132 explains how the presently claimed composition differs from that of Watanabe.

Claims 2, 4, 10, 12, and 18 depend from and contain all the limitations of claims 1, 11, or 17. The arguments regarding the lack of *prima facie* for claims 1, 11, and 17 are applicable to claims 2, 4, 10, 12, and 18.

Claims 1, 2, 4, 5, 12, 13, 15, and 17 have been rejected under 35 U.S.C § 102(b) as allegedly anticipated by Gardner et al. (*J. Phys. Chem.*).

As in Watanabe, Gardner does not disclose $\text{SnO}_x \cdot y\text{H}_2\text{O}$ as recited in claims 1, 15, and 17. This is explained in the attached declaration. As all the claim limitations have not been disclosed, a *prima facie* case of anticipation has not been made.

Claims 2, 4, 5, 12, and 13 depend from and contain all the limitations of claims 1, 15, and 17. The arguments regarding the lack of *prima facie* for claims 1, 15, and 17 are applicable to claims 2, 4, 5, 12, and 13.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, and 4-16 have been rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over Watanabe et al. (US 5,922,487, “Watanabe 487”) in view of Watanabe.

In order to make a *prima facie* case of obviousness, each claim limitation must be disclosed in the references (MPEP 2143.03). Among other deficiencies, none of the references discloses the limitation in claims 1, 11, 15, and 17 that the composition comprises $\text{SnO}_x \cdot y\text{H}_2\text{O}$.

As explained above Watanabe does not disclose it. Watanabe 487 discloses Pt/Sn alloys. No tin oxides are disclosed. As all the claim limitations of claim 1 are not disclosed in the reference, a *prima facie* case of obviousness has not been made.

Claims 2, 4-10, 12-14, and 16 depend from and contain all the limitations of claims 1, 11, or 15. The arguments regarding the lack of *prima facie* for claims 1, 11, and 15 are applicable to claims 2, 4-10, 12-14, and 16.

Claim 3 has been rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over Watanabe in view of Katayama et al. (*J. Phys. Chem.*).

As explained above Watanabe does not disclose $\text{SnO}_x \cdot y\text{H}_2\text{O}$. As stated by the Examiner, Katayama discloses Pt/SnO₂, which is not the same as the claimed composition. As all the claim limitations of claim 3 are not disclosed in the reference, a *prima facie* case of obviousness has not been made.

Claim 3 has been rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over Gardner in view of Katayama.

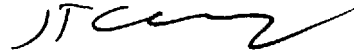
As explained above Gardner does not disclose $\text{SnO}_x \cdot y\text{H}_2\text{O}$. As stated by the Examiner, Katayama discloses Pt/SnO₂, which is not the same as the claimed composition. As all the claim limitations of claim 3 are not disclosed in the reference, a *prima facie* case of obviousness has not been made.

In view of the foregoing, it is submitted that the application is now in condition for allowance.

In the event that a fee is required, please charge the fee to Deposit Account No. 50-0281,

and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



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